

REMARKS

The Office Action dated June 23, 2004 has been carefully studied. Claims 1, 7, and 9 have been amended. Claims 11-20 have been added. Reconsideration of this application is respectfully requested.

New figure 8 has been added to support currently amended claim 9 as well as new claim 19. No impermissible new matter is introduced.

The disclosure and claims 7-10 have been objected to for some informalities. Nevertheless, the Examiner has kindly pointed out that Claims 1-6 have been allowed. Claim 1 has been slightly amended to more clearly define the subject matter. It is respectfully submitted that the claims 1-6 are in condition for allowance for the reasons recognized by the Examiner. Favorable consideration is respectfully requested.

Claims 11-16 would be allowable for the same and similar reasons as Examiner Dexter has recognized the patentability of claims 1-6 claiming similar subject matters. Favorable consideration is respectfully requested.

Examiner Dexter has rejected the originally filed claims 7-10 of the present application. For the reasons which follow, applicant respectfully traverses this rejection of the Examiner.

German Publication No. 38 30 934 (hereafter GP '934) discloses a pair of scissors including two handles that are equipped with magnets to force the handles away from each other. However, GP '934 fails to disclose connection between two pairs of scissors. In other words, the scissors of GP '934 function in a way different from that of the interconnectable hairdressing scissors of the present application. However, claim 7 has been amended to further define the through-holes in a manner to distinguish over GP '934. Thus, it is respectfully submitted that the rejections of claims 7 and claims which depend therefrom based upon GP '934 has been overcome. Favorable reconsideration is respectfully requested.

U.S. Patent No. 6,192,590 to the Applicant also fails to disclose or suggest connection between two or more pairs of hairdressing scissors using magnetic members. U.S. Patent No. 4,317,284 discloses flatware eating utensils that are connected by magnetic pieces 20, 30, and 36 in the handles when not in use. However, flatware eating utensils and hairdressing scissors are not in the same category. It is respectfully submitted that hindsight must be utilized to attempt to seek the solution in the flatware art to problems in the field of hairdressing scissors. As stated by the CCPA in *In re Van Wanderham, Worthley, and Comolli*, 154 U.S.P.Q. 20, 24, 25 (1967):

Closely related to the doctrine of nonanalogous art is the doctrine forbidding hindsight reconstruction, also discussed in Potts, supra. In applying section 103, the Supreme Court recently cautioned against “slipping into hindsight.” (case citations)

* * *

The opinion in Sporck further provides, 49 CCPA at 1043, 44, 45; 133 U.S.P.Q. at 363, 364:

Once appellant’s solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made.

* * *

It is of course true that the examiner was able to locate the Sato article. However, it appears that this was done through reading into the art the teachings of appellants’ invention. In re Murray. We think the Patent Office’s conclusion of obviousness is based on an impermissible hindsight reconstruction of the art. In re Sporck.

Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead of focusing on the scientific principle involved...

Likewise, the CCPA stated in *In re Shapleigh*, 115 U.S.P.Q. 129, 133 (1957):

The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art. (case citation)

Similarly, the CCPA in *In re Antle*, 170 U.S.P.Q. 285, 287-288 (1971) stated:

In Winslow we said that the principal secondary reference was “in the very same art” as appellant’s invention and characterized all the references as “very pertinent art.” The language relied on by the solicitor, quoted above, therefore, does not apply in cases where the very point in issue is whether one of ordinary skill in the art would have *selected*, without the advantage of hindsight and knowledge of the applicant’s disclosure, the particular references which the examiner applied. As we also said in Winslow, “Section 103 requires us to presume full knowledge by the inventor of the prior art *in the field of his endeavor*”...but it does not require us to presume full knowledge by the inventor of prior art *outside* the field of his endeavor, i.e., of

“non-analogous” art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains. (emphasis theirs)

In determining what is analogous art, the Court of Appeals for the Federal Circuit stated in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (1984):

In resolving the question of obviousness under 35 U.S.C., § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor’s endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

It is respectfully submitted that a person skilled in the art would not look to the flatware art to modify prior hairdressing scissors. It is respectfully submitted that persons working in the field of hairdressing scissors would not consider flatware to be within their field of endeavor. There is nothing in U.S. Patent No. 4,317,284 that would suggest that its teachings have application to other structure than flatware or utensils for eating, and specifically to scissors for cutting hair. Thus, U.S. Patent No. 4,317,284 fails the first determination. Additionally, there is nothing in flatware utensils and/or U.S. Patent No. 4,317,284 which is reasonably pertinent in securing utensils together when in use, the particular problem which the invention was involved. Thus, as its teachings relate to securement when not in use, U.S. Patent No. 4,317,284 fails the second determination also. It is respectfully submitted that U.S. Patent No. 4,317,284 is nonanalogous art and the rejection has been overcome.

Additionally, even assuming that U.S. Patent No. 4,317,284 is analogous art, it should

be appreciated that the reasons provided by the Examiner to show that the alleged modifications to applicant's prior hairdressing scissors are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 U.S.P.Q. 865, 870 (1983) stated:

All the pieces of the present invention were known in the art,... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 U.S.P.Q. 763, 771 (1984) quoted:

A patentable invention *** may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

The applicant recognizes that he is not the inventor of magnetic members, and that it is known that magnetic members can be utilized to secure things together. However, it is

respectfully submitted that the prior art does not provide any suggestion that it is possible or desirable to connect hairdressing scissors together for use utilizing magnetic elements. It is respectfully submitted that the Examiner has simply scanned the art in an attempt to find elements conceded not found in applicant's prior patent, and once such elements are found somewhere has reconstructed the present invention in a manner which was not suggested as being desirable in the prior art and for purposes which are not taught by the prior art. It is respectfully submitted that the conclusion of obviousness is based upon an impermissible hindsight reconstruction of the art, and the rejection has been overcome. Favorable reconsideration of the rejection based upon applicant's prior patent is respectfully submitted.

Claims 17-20 are also allowable for the same and similar reasons as set forth above for claims 7-10. Favorable consideration is respectfully requested.

In view of the foregoing amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. If any points remain in issue which the Examiner feels could best be resolved by either a personal or telephone interview, he is urged to contact Applicant's attorney at the exchange listed below.

Respectfully submitted,

Wen-Ya Yeh

Dated: September 20, 2004

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